

REMARKS

Claims 4, 6-9, 11-17, and 19-32 are pending. No new matter has been added by way of the present amendments. For instance, claims 5 and 18 have been cancelled. Additionally, claims 21 and 23 have been amended to include the subject matter of cancelled claims 5 and 18, respectively. New claims 25 and 27 are supported by Table 1-1 of Example I-1 in which a lower limit of the temperature of the heat treatment is described as 60°C. Support for newly added claims 26 and 28 can be found in Table 3-1 of Example II-1 in which some of the lower limits of the temperature of the heat treatment are described as 60°C. Support for newly added claims 29 and 30 can be found in the present specification at page 118, lines 13-14. Lastly, support for newly added claims 31 and 32 can be found in the present specification at page 196, line 22 to page 197, line 5. Accordingly, no new matter has been added.

In view of the following remarks Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims:

By way of the present amendments and remarks Applicants are responding to the Examiner's Advisory Action dated March 20, 2003 as well as the Office Action dated August 27, 2002.

Issues Under 35 U.S.C. §112, second paragraph

The Examiner had previously rejected claims 3-9, 21 and 22 under 35 U.S.C. §112, second paragraph for the reasons recited at page 2 of the Office Action dated August 27, 2002. Applicants believe that this rejection was overcome by way of the Amendment previously submitted on February 27, 2003. However, the Examiner is respectfully requested to acknowledge that this rejection has been overcome.

Issues Under 35 U.S.C. §103(a)

The Examiner has rejected claims 4, 6-8, 21 and 22 under 35 U.S.C. § 103(a) as being obvious over Fujita '866 in view of Sakai '898.

The Examiner has also rejected claims 12-17, 19, 20, 23 and 24 under 35 U.S.C. § 103(a) as being obvious over Fujita '866 in view of Ohshima '471.

The Examiner has rejected claims 9 and 11 under 35 U.S.C. § 103(a) as being obvious over Fujita '866 (or Fujita '866 in view of Sakai '898) in view of Swank '025.

Lastly, the Examiner has rejected claim 5 and 18 under 35 U.S.C. § 103(a) as being obvious over Fujita '866 (or Fujita '866 in view of Sakai '898) in view of Mifune '321.

Applicants respectfully traverse each of the above rejections.

Independent Claim 21

With respect to independent claim 21, the Examiner continues to rely on the primary reference of Fujita '866 and the secondary reference of Sakai '898. The Examiner has asserted that the declarative evidence previously submitted is, not commensurate in scope with the present claims. In particular, the Examiner asserts that independent claim 21 should recite a dispersion aid. Applicants traverse and submit that claim 21 has been amended to recite a dispersion aid, thus, this concern of the Examiner is moot.

→ The Examiner also asserts that the comparative results with respect to the cyan dye-forming coupler (Formula C-2) are not commensurate in scope with the present claims. Applicants respectfully disagree with the Examiner in this regard. Even though coupler 41 of Sakai may fall within the preferred embodiment of the present invention, it is still the closest prior art compound. The comparative showing need not compare the claimed invention with all of the cited prior art, In re Fenn et al., 208 USPQ 470 (CCPA 1981), but only with the closest prior art. In re Holladay, 199 USPQ 516 (CCPA 1978); see also In re Merchant, 197 USPQ 785 (CCPA 1978); see also In re Wood et al., 202 USPQ 171 (CCPA 1979). In the case of chemical compounds, this means only the compound or compounds closest structurally thereto must be tested.

In the present instance, out of all the cyan couplers disclosed in Sakai '898, coupler 41 alone is included within the present formula C-2, while the other couplers of Sakai '898 differ greatly in chemical structure from compounds represented by the present formula C-2. In comparing the present invention with the combination of prior art closest to the present invention, the coupler 41 of Sakai '898 was chosen and the coupler C-3 disclosed in Fujita '866 was used as a comparative coupler. Accordingly, the evidence submitted is fully commensurate in scope with the present claims. Moreover, based upon the unexpected results obtained by the present invention, the Examiner's rejection under 35 USC § 103(a) is overcome. Reconsideration and withdrawal thereof are requested.

*Sakai vs. Fujita*  $\Rightarrow$  Sakai's Coupler  
dilution ↑ in shadows  
much better results

#### Independent Claim 23

Regarding independent claim 23 the Examiner continues to maintain that Fujita '866 discloses materials having a pH of 6.2. Applicants disagree with the Examiner. Applicants respectfully request that the Examiner carefully review the following remarks.

The pH disclosed by Fujita '866 of 6.2 is simply the pH of the emulsion. However, this is not what Applicants are claiming. Present claim 23 requires that the pH of the light-sensitive material have a film pH of from 4.6 to 6.4. The pH of the emulsion is not the same as the film pH of the light-

sensitive material. Thus, even though the numerical value of 6.2 may fall within the range of 4.6 to 6.4, it is not the film pH of the light-sensitive material (as claimed), but rather the pH of the emulsion.

Present claim 23 further requires the presence of a dispersion aid. Accordingly, none of the subject matter disclosed in claim 23, or the claims that which depend thereon are suggested by the cited art.

The secondary references cited by the Examiner fail to cure the deficiencies of the primary references as discussed above.

In summary, Applicants respectfully submit that the Examiner has failed to present a valid *prima facie* case of obviousness. The cited references, whether taken individually or as a whole, fail to suggest or disclose the presently claimed subject matter. Moreover, even if the Examiner has hypothetically presented a valid *prima facie* case of obviousness, the unexpected results of the present invention compared to the cited art rebut any hypothetical case of obviousness. Accordingly, the Examiner's rejections are moot. Reconsideration and withdrawal thereof are respectfully requested.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Pursuant to 37 C.F.R. 1.17 and 1.136(a), the Applicant respectfully petitions for a three (3) month extension of time for filing a response in connection with the present application. The required extension fee of \$930.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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